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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,574	11/21/2001	Pravin T.P. Kaumaya	18525/04028	2019

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EXAMINER

OUSPENSKI, ILIA I

ART UNIT PAPER NUMBER

1644

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,574

Applicant(s)

KAUMAYA ET AL.

Examiner

ILIA OUSPENSKI

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,10,13,17,18,20,26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) 17,18,20,26 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,10 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>1/18/2006</u> |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's amendment/remarks, filed 12/08/2005, are acknowledged, and have been entered.

Claims 2, 7-9, 11, 12, 14-16, 19, 21-25, and 28-32 have been cancelled previously.

Claims 4 – 6 have been amended.

Claims 1, 3-6, 10, 13, 17, 18, 20, 26, and 27 are pending.

Claims 17, 18, 20, 26, and 27 have been withdrawn from consideration by the Examiner as being drawn to nonelected inventions.

Claims 1, 3 – 6, 10, and 13 are under consideration in the instant application.

2. This Office Action will be in response to applicant's arguments, filed 12/08/2005.

The rejections of record can be found in the previous Office Action, mailed 08/31/2005.

It is noted that new grounds of rejection are set forth herein.

3. Applicant's amendment has obviated the objection of record.

4. The Declaration under 37 CFR1.132 by Dr. Pravin T.P. Kaumaya, filed on 12/18/2005, is acknowledged, and has been entered.

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1, 3 – 6, 10, and 13 stand rejected under **35 U.S.C. 102(a)** as being anticipated by Srinivasan et al. (1999, reference AK on IDS filed 03/24/2003; see entire document), as evidenced by the instant specification on page 14.

The following is a rejection of record, set forth in the Office Action mailed 12/15/2004:

Srinivasan et al. teach a retro-inverso peptide analog of CD28 (page 689 paragraph 2).

Srinivasan et al. teach that the end groups of the peptide can be blocked (ibid), and that the peptide binds B7-1 protein with a higher affinity than the native CD28, and inhibits proliferation and IL-2 production of CD4⁺ T cells (page 689 paragraph 3). The instant specification defines the retro-inverso peptide analog of CD28 as the peptide of SEQ ID NO:6. Thus it is inherent in the teachings of Srinivasan et al. that the retro-inverso peptide analog of CD28 has the sequence set forth in SEQ ID NO:6, and has the same conformation and binding affinity as the peptide of SEQ ID NO:6.

Applicant's Declaration under 37 CFR1.132 by Dr. Pravin T.P. Kaumaya has obviated the rejection of record under 35 USC 102(b).

However, the reference of Srinivasan et al. provides *prima facie* evidence under 35 USC 102(a) that the invention was known or used by others in this country.

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The reference lists authors M. Srinivasan, R. Wardrop, C. Whitcare, and P. Kaumaya, whereas the co-inventors of the instant application are M. Srinivasan, C. Whitcare, and P. Kaumaya. Therefore, the author R. Wardrop, who is not a co-inventor of the instantly claimed subject matter, was in possession of the claimed peptide analog prior to the filing date of the instant application.

The Declaration by Dr. Kaumaya states that Ms. Srinivasan, who is an author of the reference and a co-inventor of the instantly claimed subject matter, has been specifically instructed not to discuss the sequence of the claimed peptide analog with others. However, the Declaration is silent with regard to Mr. Wardrop, who is thus assumed not to be bound by a confidentiality obligation, and at liberty to disclose the sequence of the claimed peptide analog to others. Therefore, the reference of Srinivasan et al. provides *prima facie* evidence under 35 USC 102(a) that the invention was known or used by others in this country.

Applicant is invited to provide evidence that Mr. Waldrop was not in possession of the claimed invention prior to the filing date of the instant application, or, alternatively, that Mr. Waldrop was under instructions not to disclose the sequence of the claimed peptide analog to others prior to the filing date of the instant application.

7. Conclusion: no claim is allowed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ILIA OUSPENSKI whose telephone number is 571-272-2920. The examiner can normally be reached on Monday-Friday 9 - 5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 571-272-0841. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ILIA OUSPENSKI

Patent Examiner

Art Unit 1644

February 7, 2006

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2/7/06